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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: KELLY, Daniel P.

DATE: April 12, 2004

SERIAL NO.: 09/771,782

GROUP ART UNIT: 1732

FILED: 29 January 2001

EXAMINER: Edmund H. Lee

FOR: "Sports Projectile Shaped Bead Necklace and Method of Manufacture"

Attorney Docket No.: A00219US (98361.3)

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
BRIEF OF APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

On 7 October 2003, the Examiner finally rejected Claims 37-43 and 47-49 of the above-referenced patent application. A Notice of Appeal was filed on 7 January 2004, and was received by the USPTO on 12 January 2004. This brief, required by 37 C.F.R. § 1.192(a), was due on 12 March 2004 (see 37 C.F.R. § 1.8(a)(2) and MPEP § 512 (Eighth Edition First Revision (E8R1) 02/2003)); it is in the form required by 37 C.F.R. § 1.192(c).

CERTIFICATE OF MAILING

I hereby certify that **the original and two copies** of this Appeal Brief are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 12th day of April, 2004.

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Seth M. Nehrbass, Reg. No. 31,281

(1) REAL PARTY IN INTEREST:

The real parties in interest are the applicant, Beads By The Dozen, Inc. (a Louisiana corporation), and Innovative Marketing, the licensee.

(2) RELATED APPEALS AND INTERFERENCES:

There are no related appeals or interferences.

(3) STATUS OF CLAIMS:

Claims 1 through 36 and 46 have been cancelled. Claims 37-45 and 47-49 are pending (claims 44 and 45 are withdrawn from consideration). Claims 37-43 and 47-49 were again rejected under 35 U.S.C. § 103(a) as being unpatentable over Bateholts in view of the admitted prior art mentioned on page 1 of the present patent application.

The rejection of Claims 37-43 and 47-49 is being appealed.

(4) STATUS OF AMENDMENTS:

No amendments after final have been filed.

(5) SUMMARY OF INVENTION:

As suggested by MPEP § 1206, Applicant has read some of the appealed claims on the specification and drawings. These claims follow.

37. A method of making necklaces, comprising the steps of:
providing a mold of sports projectile shaped beads for a necklace (see page 5, line 18 through page 6, line 5, and Figures 13 and 14);
placing a string or other line or cord in the mold (see Figures 13 and 14);
supplying plastic to the mold (see Figures 13 and 14);
removing from the mold a necklace formed of sports projectile shaped beads direct-molded onto the string or other line or cord (see Figure 11).

38. The method of claim 37, further comprising attaching an additional sports projectile shaped bead to the necklace, wherein the additional sports projectile shaped bead is larger than the sports projectile shaped beads direct-molded onto the string or other line or cord (see Fig. 1).

39. (previously presented) The method of claim 37, wherein the sports projectile shaped beads are football-shaped beads (see Fig. 1).

47. (previously presented) The method of claim 37, further comprising attaching one

or more pendants to the necklace, wherein the pendant is larger than the sports projectile shaped beads (see Figs. 1 or 9).

(6) ISSUES:

- (i) (There are no 35 U.S.C. § 112, first paragraph rejections.)
- (ii) (There are no 35 U.S.C. § 112, second paragraph rejections.)
- (iii) (There are no 35 U.S.C. § 102 rejections.)
- (iv) Are claims 37-43 and 47-49 patentable over Bateholts and the admitted prior art mentioned on page 1 of the present patent application under 35 U.S.C. § 103(a)?

(7) GROUPING OF THE CLAIMS:

The rejected claims do not stand or fall together. Based on the references cited and arguments made by the Examiner, the claims are grouped together in particular combinations in part (8) for convenience. Applicant reserves the right to regroup the claims or to argue the patentability of each claim individually should new references be cited or new arguments or rejections be made.

(8) ARGUMENT:

- (i) (There are no 35 U.S.C. § 112, first paragraph rejections.)
- (ii) (There are no 35 U.S.C. § 112, second paragraph rejections.)
- (iii) (There are no 35 U.S.C. § 102 rejections.)
- (iv) Claims 37-43 and 47-49 are patentable over Bateholts and the admitted prior art mentioned on page 1 of the present patent application under 35 U.S.C. § 103(a)

Claims 37-43 and 47-49 were again rejected under 35 U.S.C. § 103(a) as being unpatentable over Bateholts in view of the admitted prior art mentioned on page 1 of the present patent application. Applicant respectfully traverses this rejection.

Bateholts is part of the admitted prior art mentioned on page 1 of the present patent application as filed. Applicant was aware before filing the present patent application of all of the art now cited by the patent examiner against the present claims. Applicant believed that the invention was patentable when the application was filed and still believes that the invention is patentable. The Declaration of Daniel Kelly dated 29 January 2003 submitted with the response dated 30 January 2003 mentions how the present inventor was aware since around 1991 of art equivalent to the art now cited by the patent examiner against the claims, yet neither he nor anyone

he knew found it obvious to combine that prior art to arrive at the invention as now claimed.

Attached to the response dated 31 July 2003 is a declaration of the inventor clarifying that he was not aware before he invented the present invention of any necklaces with solid sports beads.

The patent examiner cites reasons why one would wish to add the features of the dependent claims to the independent claims. While all these reasons seem logical now, it does not mean that the invention would have been obvious at the time it was made.

The Examiner alleges that it would be obvious to combine the prior art mentioned by the patent applicant at page 1 of the application as filed to arrive at applicant's invention as claimed in Claims 37-43 and 47-49. Applicant respectfully disagrees with this allegation.

The prior art mentioned by the patent applicant at page 1 of the application as filed merely shows that some elements of the claimed invention are old. "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." Environmental Designs, Ltd. v. Union Oil Co., 218 USPQ 865, 870 (CAFC 1983). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under [35 U.S.C.] Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (CAFC 1984) and cases cited therein (emphasis in original). Applicant has stated in his declaration of 29 January 2003 that it was not obvious to him or anyone he knew to combine the teachings of the prior art of which he was aware to reach applicant's invention.

Thus, "[t]here is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing" a method as claimed in the rejected claims. In re Deminski, 230 USPQ 313, 315 (CAFC 1986) and cases cited therein (emphasis in original). It is therefore respectfully submitted that the rejected claims are allowable.

Declarations of the inventor were submitted in prior responses, and are respectfully submitted to be evidence of non-obviousness of the invention. Specifically, the 31 October 2002 declaration is evidence of copying by others, the 23 January 2003 declaration is evidence of licensing by others

and copying by others, the 29 January 2003 declaration is evidence of licensing to others, copying by others, and commercial success, and the 31 July 2003 declaration is evidence of licensing to others, copying by others, and commercial success; all of these are indications of non-obviousness of the invention. Applicant requests that the Patent and Trademark Office consider this evidence of non-obviousness when considering the patentability of the claims under 35 U.S.C. § 103(a) (see, e.g., MPEP Sections 716.01(a) through 716.06).

The examiner stated that no nexus has been shown between the commercial success and the claimed invention. Attached to the response filed today by fax is a declaration of Dan Kelly dated 7 April 2004 comparing sales of the necklaces made by the claimed method to prior art sports necklaces, and showing that sales increased dramatically when the necklaces made by the claimed method were introduced (the average number of necklaces sold per year increased from about 42 gross (about 6048 necklaces) in 1996-1999 to about 8,100 gross (about 1,166,400 necklaces) in 2000-2004, and the average revenue per year increased from about \$10,000 in 1996-1999 to about \$300,000 in 2000-2004). It is respectfully submitted that this demonstrates a nexus between the claimed invention and the commercial success.

Applicant respectfully submits that the application is in condition for allowance. A Notice of Allowance is hereby respectfully requested.

CONCLUSION:

For the foregoing reasons, applicant respectfully submits that all claims remaining in the application are allowable. A Notice of Allowance is hereby respectfully requested.

TELEPHONE CONFERENCE INVITATION:

Should the Examiner or any member of the Board feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

PETITION FOR EXTENSION OF TIME:

Applicant hereby petitions the Commissioner under 37 C.F.R. § 1.136 for a one-month extension of time necessary to render this Appeal Brief timely filed. A check including the \$55 fee is enclosed.

Applicant hereby petitions the Commissioner under 37 C.F.R. § 1.136 for any other extension

of time necessary to render this Appeal Brief timely filed, and asks that the fee for any such extension be charged to Deposit Account No. 50-0694.

FEES:

A \$220 check for the \$165 fee required by 37 C.F.R. § 1.192(a) and § 1.17(f) and the extension fee is enclosed. Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,



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(9) APPENDIX:
CLAIMS ON APPEAL:

37. (original) A method of making necklaces, comprising the steps of:
providing a mold of sports projectile shaped beads for a necklace;
placing a string or other line or cord in the mold;
supplying plastic to the mold;
removing from the mold a necklace formed of sports projectile shaped beads direct-molded onto the string or other line or cord.

38. (original) The method of claim 37, further comprising attaching an additional sports projectile shaped bead to the necklace, wherein the additional sports projectile shaped bead is larger than the sports projectile shaped beads direct-molded onto the string or other line or cord.

39. (previously presented) The method of claim 37, wherein the sports projectile shaped beads are football-shaped beads.

40. (previously presented) The method of claim 37, wherein the sports projectile shaped beads are baseball-shaped beads.

41. (previously presented) The method of claim 37, wherein the sports projectile shaped beads are basketball-shaped beads.

42. (previously presented) The method of claim 37, wherein the sports projectile shaped beads are soccer ball-shaped beads.

43. (previously presented) The method of claim 37, wherein the sports projectile shaped beads are hockey-puck-shaped beads.

47. (previously presented) The method of claim 37, further comprising attaching one or more pendants to the necklace, wherein the pendant is larger than the sports projectile shaped beads.

48. (previously presented) The method of claim 37 further comprising the step of attaching a pendant to the necklace that is colored with two colors.

49. (previously presented) The method of claim 48 wherein the pendant is of a sports team logo shape.